

M



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,018	11/21/2001	Hijin Sato	15689.93	9490

22913 7590 11/02/2004

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &
SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER

QUINONES, ISMAEL C

ART UNIT PAPER NUMBER

2686

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/989,018		SATO ET AL.	
	Examiner		Art Unit	
	Ismael Quiñones		2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8 and 15-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20040824</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on July 22nd, 2004. **Claims 1, 8, and 15-25** are now pending in the present application. **This Action is made FINAL.**

Claim Objections

2. **Claim 8** is objected to because of the following informalities:

In line 5, it is suggested the removal of "a" after "the", in the phrase "the a mobile station". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claim 25** is rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al. (U.S Pat. No. 6,070,081).

Regarding **claim 25**, Takahashi et al. disclose a multi-network connection communication system (A radio base station that enables communications to a private and a public system/network; *col. 4, lines 41-46 and lines 62-65; col. 5, lines 26-32; col.*

Art Unit: 2686

8, lines 60-65; *See Figs. 10, 16 and 17*) comprising: connection decision means for making a decision as to whether a mobile station is to be connected to a carrier network or a private network (Wherein if a mobile radio telephone or terminal located that does not belong to a private system, furthermore located within the area of said system, is enabled a public connection through the system, otherwise if the terminal belongs or is registered to the private system requests connection, the system grants a connection in the system to the terminal; *col. 7, lines 50-55; col. 8, lines 17-39; See Fig. 10*); and means for connecting said mobile station to said carrier network or said private network in accordance with the decision result (Wherein the base station comprises means for connecting said terminal such as private and public protocol processing sections; *col. 10, line 65 thru col. 11, line 17; col. 12, lines 2-19*), wherein said system further comprises: means for receiving a signal from a mobile station or the carrier network (*Fig. 10, item 21*); and means for managing registration of mobile stations that use the system as the private network (The PBX authenticating for those portable or mobile radio telephone equipment (*Fig. 8, item 5*) who sent a request for connection through a private base station (*Fig. 8, item 4*); *col. 8, lines 7-11; col. 9, lines 21-28*), wherein said connection decision means decides based on the registration of mobile stations, whether the signal is to be transmitted to a mobile station or the carrier network (Wherein if a portable or radio telephone equipment belongs to the private network (*Fig. 8, item 5*) the PBX performs connection to the private network, therefore a private base station sending a signal to the private network/system and ultimately to the portable or radio telephone equipment, otherwise if the portable or radio telephone equipment does not belong to the private network the PBX different system protocol controlling section (*Fig. 11, item 36*)

Art Unit: 2686

transmits a signal through a network interface (*Fig. 11, item 35*) and allows related information to pass from a public/carrier network to the corresponding portable or mobile radio telephone equipment; *col. 2, line 59 thru col. 3, line 7; col. 3, line 64 thru col. 4, line 8; col. 7, line 66 thru col. 8, line 2; col. 8, lines 17-53*), and said means for connecting transmits the signal to the mobile station or the carrier network based on the decision result of said connection decision means (Wherein the decision pertains if the portable or mobile radio telephone equipment belongs to a private system/network; *col. 7, lines 8-24*).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

Art Unit: 2686

various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. **Claims 1, 8, and 15-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (U.S Pat. No. 6,070,081) in view of Aldermeshian et al. (U.S Pat. No. 5,745,850).

Regarding **claim 1**, Takahashi et al. disclose a base station for use in a multi-network connection communication system (A radio base station that enables communications to a private and a public system/network; *col. 4, lines 41-46 and lines 62-65; col. 5, lines 26-32; col. 8, lines 60-65; See Figs. 10, 16 and 17*) comprising: connection decision means for making a decision as to whether a mobile station is to be connected to a carrier network or a private network (Wherein if a mobile radio telephone or terminal located that does not belong to a private system, furthermore located within the area of said system, is enabled a public connection through the system, otherwise if the terminal belongs or is registered to the private system requests connection, the system grants a connection in the system to the terminal; *col. 7, lines 50-55; col. 8, lines 17-39; See Fig. 10*); and means for connecting said mobile station to said carrier network or said private network in accordance with the decision results (Wherein the base station comprises means for connecting said terminal such as private and public protocol

Art Unit: 2686

processing sections; *col. 10, line 65 thru col. 11, line 17; col. 12, lines 2-19*), means for receiving a signal from a mobile station or the carrier network (*Fig. 10, item 21*); and means for managing registration of mobile stations that use the base station as the private network (The PBX authenticating for those portable or mobile radio telephone equipment (*Fig. 8, item 5*) who sent a request for connection through a private base station (*Fig. 8, item 4*); *col. 8, lines 7-11; col. 9, lines 21-28*); said connection decision means decides based on the registration of mobile stations, whether the signal is to be transmitted to a mobile station or the carrier network (Wherein if a portable or radio telephone equipment belongs to the private network (*Fig. 8, item 5*) the PBX performs connection to the private network, therefore a private base station sending a signal to the private network/system and ultimately to the portable or radio telephone equipment, otherwise if the portable or radio telephone equipment does not belong to the private network the PBX different system protocol controlling section (*Fig. 11, item 36*) transmits a signal through a network interface (*Fig. 11, item 35*) and allows related information to pass from a public/carrier network to the corresponding portable or mobile radio telephone equipment; *col. 2, line 59 thru col. 3, line 7; col. 3, line 64 thru col. 4, line 8; col. 7, line 66 thru col. 8, line 2; col. 8, lines 17-53*); and said means for connecting transmits the signal to the mobile station or the carrier network based on the decision result of said connection decision means (Wherein the decision pertains if the portable or mobile radio telephone equipment belongs to a private system/network; *col. 7, lines 8-24*). Takahashi et al. fail to clearly specify wherein the registering management, and the decision for discriminating whether a mobile station belongs or not to a private network is directly done at the base station.

In the same field of endeavor, Aldermeshian et al. disclose a base station that includes the capabilities of a private branch exchange, furthermore registering portable devices and managing calls related to those portable devices (*col. 11, line 53 thru col. 12, line 9*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Takahashi et al. private base station and private branch exchange for connecting a mobile station based on its network identity to implement both features of a base station and a private branch exchange in a single unit as taught by Aldermeshian et al. for the purpose of minimizing the network architecture and furthermore preventing delay when transferring information from a base station to private branch exchange.

Regarding **claim 8**, Takahashi et al. disclose a connecting method for use in a base station for use in a multi-network connection communication system (A radio base station that enables communications to a private and a public system/network; *col. 4, lines 41-46 and lines 62-65; col. 5, lines 26-32; col. 8, lines 60-65; See Figs. 10, 16 and 17*), comprising means for: managing registration of mobile stations that use the base station as a private network (The PBX authenticating for those portable or mobile radio telephone equipment (*Fig. 8, item 5*) who sent a request for connection through a private base station (*Fig. 8, item 4*); *col. 8, lines 7-11; col. 9, lines 21-28*), a connection decision step of making a decision as to whether the mobile station is to be connected to a carrier network or a private network (Wherein if a mobile radio telephone or terminal located that does not belong to a private system, furthermore located within the area of said system, is enabled a public connection through the system, otherwise if the terminal

Art Unit: 2686

belongs or is registered to the private system requests connection, the system grants a connection in the system to the terminal; *col. 7, lines 50-55; col. 8, lines 17-39; See Fig. 10*); a step of connecting said mobile station to said carrier network or said private network in accordance with the decision result (Wherein the base station comprises means for connecting said terminal such as private and public protocol processing sections; *col. 10, line 65 thru col. 11, line 17; col. 12, lines 2-19*), wherein said method further comprises a step of receiving a signal from a mobile station or the carrier network (*Fig. 10, item 21*), wherein said connection decision step decides based on the registration of mobile stations, whether the signal is to be transmitted to a mobile station or the carrier network (Wherein if a portable or radio telephone equipment belongs to the private network (*Fig. 8, item 5*) the PBX performs connection to the private network, therefore a private base station sending a signal to the private network/system and ultimately to the portable or radio telephone equipment, otherwise if the portable or radio telephone equipment does not belong to the private network the PBX different system protocol controlling section (*Fig. 11, item 36*) transmits a signal through a network interface (*Fig. 11, item 35*) and allows related information to pass from a public/carrier network to the corresponding portable or mobile radio telephone equipment; *col. 2, line 59 thru col. 3, line 7; col. 3, line 64 thru col. 4, line 8; col. 7, line 66 thru col. 8, line 2; col. 8, lines 17-53*), and said step of connecting transmits the signal to the mobile station or the carrier network based on the decision result of said connection decision step (Wherein the decision pertains if the portable or mobile radio telephone equipment belongs to a private system/network; *col. 7, lines 8-24*). Takahashi et al. fail to clearly specify wherein the registering management is directly done at the base station.

In the same field of endeavor, Aldermeshian et al. disclose a base station that includes the capabilities of a private branch exchange, furthermore registering portable devices and managing calls related to those portable devices (*col. 11, line 53 thru col. 12, line 9*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Takahashi et al. private base station and private branch exchange for connecting a mobile station based on its network identity to implement both features of a base station and a private branch exchange in a single unit as taught by Aldermeshian et al. for the purpose of minimizing the network architecture and furthermore preventing delay when transferring information from a base station to private branch exchange.

Regarding **claims 15 and 20**, and as each respectively applied to claims 1 and 8, Takahashi et al. in view of Aldermeshian et al. disclose the aforementioned base station and method. In addition Takahashi et al. disclose the base station and method further comprising service area decision means for making a decision of a service area based on the signal (*Fig. 10, items 25 and 23*), and said connection decision means decides based on the registration of mobile stations and the decision result of said service area decision means, whether the signal is to be transmitted to a mobile station or the carrier network (Wherein if a portable or radio telephone equipment belongs to the private network (*Fig. 8, item 5*) the PBX performs connection to the private network, therefore a private base station sending a signal to the private network/system and ultimately to the portable or radio telephone equipment, otherwise if the portable or radio telephone equipment does not belong to the private network the PBX different system protocol controlling section

Art Unit: 2686

(*Fig. 11, item 36*) transmits a signal through a network interface (*Fig. 11, item 35*) and allows related information to pass from a public/carrier network to the corresponding portable or mobile radio telephone equipment; *col. 2, line 59 thru col. 3, line 7; col. 3, line 64 thru col. 4, line 8; col. 7, line 66 thru col. 8, line 2; col. 8, lines 17-53*).

Regarding **claims 16 and 21**, and as each respectively applied to claims 1 and 8, Takahashi et al. in view of Aldermeshian et al. disclose the aforementioned base station and method. In addition Takahashi et al. disclose wherein said connection decision means transmits the signal to the carrier network, if a mobile station which is a destination of the signal is not registered in said means for managing (The private branch exchange (PBX) discriminating whether a portable or radio telephone equipment belongs to a private network or not, if the portable or radio telephone equipment does not belong to the private network the PBX different system protocol controlling section (*Fig. 11, item 36*) transmits a signal through a network interface (*Fig. 11, item 35*) and allows related information to pass from a public network to the corresponding portable or mobile radio telephone equipment; *col. 2, line 59 thru col. 3, line 7; col. 3, line 64 thru col. 4, line 8; col. 7, line 66 thru col. 8, line 2; col. 8, lines 17-53*).

Regarding **claims 17 and 22**, and as each respectively applied to claims 1 and 8, Takahashi et al. in view of Aldermeshian et al. disclose the aforementioned base station and method. In addition Takahashi et al. disclose wherein said means for receiving receives a signal from a mobile station (*Fig. 10, item 21*).

Regarding **claims 18 and 23**, and as each respectively applied to claims 1 and 8, Takahashi et al. in view of Aldermeshian et al. disclose the aforementioned base station and method. In addition Takahashi et al. disclose wherein said means for receiving

Art Unit: 2686

receives a signal from the carrier network (*col. 8, lines 27-48 and 59-65; Fig. 10, items 25 and 24*).

Regarding **claims 19 and 24**, and as each respectively applied to claims 1 and 8, Takahashi et al. in view of Aldermeshian et al. disclose the aforementioned base station and method. In addition Takahashi et al. disclose the base station and method further comprising means for receiving a registration request for using the base station as the private network from a mobile station (A connection request from a portable or mobile radio telephone equipment that belongs to the private network; *col. 2, line 59 thru col. 3, line 7; col. 3, line 64 thru col. 4, line 8; col. 7, line 66 thru col. 8, line 2; col. 8, lines 17-53*), and furthermore wherein a private branch exchange (PBX) authenticates or registers those portable or mobile radio telephone equipment (*Fig. 8, item 5*) who sent a request for connection through a private base station (*Fig. 8, item 4*) (*See col. 8, lines 7-11; col. 9, lines 21-28*). Takahashi et al. fail to clearly specify wherein the registering management for the mobile station is directly done at the base station.

In the same field of endeavor, Aldermeshian et al. disclose a base station that includes the capabilities of a private branch exchange, furthermore registering portable devices and managing calls related to those portable devices (*col. 11, line 53 thru col. 12, line 9*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Takahashi et al. private base station and private branch exchange for connecting a mobile station based on its network identity to implement both features of a base station and a private branch exchange in a single unit as taught by Aldermeshian et al. for the purpose of minimizing the network architecture

Art Unit: 2686

and furthermore preventing delay when transferring information from a base station to private branch exchange.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Williams (U.S. Pat. No. 6,363,246), Call Routing Method for a Radiotelephone in Multiple Radiotelephone Systems.
- b. Ludwig et al. (U.S. Pat. No. 5,590,172), Method and System for Transferring a Radiotelephone Call from One Coverage Area to Another.
- c. Ramaswamy (U.S. Pat. No. 6,643,512), Method and Apparatus for Spanning Operation of a Cellular Telephone.
- d. Fukuda (JP 10-136461), Private Branch Exchange System.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2686

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any response to this Office Action should be **faxed to** (703) 872-9306 or **mailed to:**

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Crystal Park II

2021 Crystal Drive

Arlington, VA 22202

Sixth Floor (Receptionist)

12. Any inquiry concerning this communication on earlier communications from the Examiner should be directed to Ismael Quiñones whose telephone number is (703) 305-8997. The Examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

13. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone

Art Unit: 2686

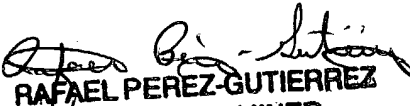
number for the organization where this application or proceeding is assigned is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose number is (703) 305-4700 or call customer service at (703) 306-0377.

Ismael Quiñones

I.Q

October 19, 2004


RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER
10/26/04